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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,305	08/20/2001	James Randall Turner	PA1533US	8301

7590

08/12/2005

James H. Salter  
Blakely, Sokoloff, Taylor & Zafman LLP  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025

EXAMINER

HU, JINSONG

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,305

Applicant(s)

TURNER, JAMES RANDALL

Examiner

Jinsong Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-19 are presented for examination. Claims 1-5 and 10-13 have been amended; Claims 20-21 are newly added claims.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirai et al. (Pub. No. US 2001/0056499).

4. As per claims 1 and 2, Shirai teaches the invention substantially as claimed including a method for automatically selecting and assigning non-overlapping IP addresses [col. 1, paragraph 1] comprising the steps of:

setting an internal address space to a default private IP address space [col. 1, paragraph 1; col. 3, paragraphs 36-37]

receiving a provider's private IP address and range [Fig. 10; col. 1, paragraphs 6-8; col. 4, paragraphs 55-56; col. 5, paragraph 66-68; i.e., collected IP addresses for all of those devices will find out a provider's private IP address, because a device's IP addresses includes it's host address, which is provider's private address];

determining if the default IP address space overlaps with the provider private IP address and range [col.3, paragraphs 46-47; col. 4, paragraph, 4]; and

selecting a largest available non-overlapping private IP address space if the default private IP address space overlaps with the provider private IP address and range, [col. 3, paragraph 47; col. 4, paragraphs 57 and 61].

5. As per claim 3, Shirai teaches the step of iterating through each available private IP address space to find the largest available non-overlapping private IP address space [col. 4, paragraph 57].

6. As per claim 4, Shirai teaches the step of selecting from the default IP address space a private IP address and assigning the selected private IP address to a network device if the default private IP address space does not overlap with the provider private IP address and range [col. 1, paragraph 8; col. 3, paragraphs 46-47].

7. As per claim 5, Shirai teaches the step of selecting a private IP address from the largest available non-overlapping private IP address space and assigning the selected

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private IP address to a network device if the default private IP address space overlaps with the provider private IP address and range [col. 4, paragraph 57].

8. As per claims 6-9, since they are system claims of claims 1 and 3-5, they are rejected for the same basis as claims 1 and 3-5 above.

9. As per claim 10-13, since they are computer program claims of claims 1 and 3-5, they are rejected for the same basis as claims 1 and 3-5 above.

10. As per claims 14-19, since they are apparatus claims of claims 1-5, they are rejected for the same basis as claims 1-5 above.

### ***Conclusion***

11. Applicant's arguments for claims 1-19 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicant argued in substance that Shirai does not teach private IP address.

12. Examiner respectfully traverses applicant's remarks:

There is no claim language directing to the private IP address cannot be identified over the Internet. Furthermore, Shirai discloses a IP address includes a network address and a host address, the devices connected to the same LAN only have

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same network address, not a host address, and it is well known that a IP address is a 32-bit globally unique address on a network, on the other words, even inside same network, different device should have different IP address. Thus, Shirai teaches the limitation in claim 1, it is still a relevant prior art.

13. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (571) 272-3965. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone

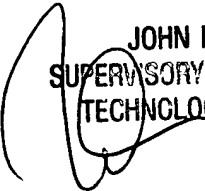
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number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinsong Hu

August 4, 2005

 JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100